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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,752	03/15/2001	Scott M. Zimmerman	OM-1670	4335

7590 01/29/2003

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EXAMINER

ALANKO, ANITA KAREN

ART UNIT PAPER NUMBER

1765

DATE MAILED: 01/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,752

Applicant(s)

ZIMMERMAN ET AL.

Examiner

Anita K Alanko

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1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 and 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6 . 6) ☐ Other:

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, 35-42, drawn to a method, classified in class 216, subclass 13.
- II. Claims 27-34, drawn to a product, classified in class 174, subclass 255.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a different process such as etching or sand blasting a substrate and then sequentially depositing a polymer and metal layer, instead of laminating a metal/polymer layer to a polymer substrate.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Richard Roberts on January 16, 2003 a provisional election was made with traverse to prosecute the invention of Group II, claims 27-34.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-26, 35-42 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27, 29-34 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Takeuchi et al (U.S. Patent No. 6,252,010 B1).

Takeuchi discloses a composite comprising:

- a polymeric substrate having a first etched surface (col.14, lines 6-15),
- a first polymeric film attached to the first etched surface of the substrate (col.14, lines 16-20), and
- a layer of a metal foil attached to an opposite side of the first polymeric film (col.14, lines 21-22).

As to claims 29-32, the substrate and first polymeric film comprise a polyimide and the metal film comprises copper (col.14, lines 6-22).

As to claims 33-34, the first polymeric film has a thickness of 30 microns or less (col.14, lines 25-26) and the metal foil has a thickness of 18 microns (col.23, lines 5-9).

Claims 27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Viehbeck et al (U.S. Patent No. 5,203,955).

Viehbeck discloses a composite comprising:

- a polymeric substrate having a first etched surface (col.15, lines 64-69; col.17, lines 30-56),
- a first polymeric film attached to the first etched surface of the substrate (since polyimide is bonded to polyimide), and
- a layer of a metal foil attached to an opposite side of the first polymeric film (col.18, lines 11-14, since the polyimide is circuitized, it encompasses comprising a metal foil).

As to claim 28, Viehbeck discloses that circuitized layers are stacked, which encompasses repeating the process several times (col.18, lines12-13).

As to claims 29-32, the substrate and first polymeric film comprise a polyimide and the metal film comprises copper (col.19, line 20).

As to claims 33-34, the first polymeric film has a thickness of 50 microns (col.19, line 12) and the metal foil has a thickness of 17 microns (col.19, line 29).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita K Alanko whose telephone number is 703-305-7708. The examiner can normally be reached on Monday-Friday, 10:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin L Utech can be reached on 703-308-3836. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9057 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Anita K. Alanko

Anita K Alanko
Primary Examiner
Art Unit 1765

AKA

January 21, 2003